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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,885	10/17/2001	Robert E. Haines	10013718-1	7082

7590 05/31/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DICUS, TAMRA

ART UNIT PAPER NUMBER

1774

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/981,885	Applicant(s) HAINES, ROBERT E.	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the appeal brief filed on 03-10-05, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1 and 31 recite “the single fluid-based marking comprises data for configuring an imaging device”, and “the data is for configuring the image device to form images on the

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sheet”, respectively, however, Applicant’s specification on page 9, lines 17-19 recite the image forming device is configured to form images upon print media. Thus it is not clear how said marking comprises data for configuring an image device or how data configures an image device.

6. Claims 3 recite “the single respective fluid-based marking was imprinted on the edge portion and not imprinted on the facial portion”. This is confusing and appears contradictory, as claim 3 depends on claim 1 that states “the single fluid-based marking being on a facial portion of the facial portions **and** on an edge portion of the edge portions”. Based on this contradiction, claim 3 could be a different invention and would be distinct from claim 1, thereby requiring a restriction.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN

6,090,027 to Brinkman.

Brinkman teaches a sheet of print media (Brinkman, Fig. 14A-14C, 16A-16C and associated text), the sheet comprising: facial portions; edge portions; a single fluid-based

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marking positioned on a facial portion and on an edge portions, the edge portions covering an area that is adjacently positioned and substantially perpendicular to an area of the facial portion; and wherein the single fluid-based marking comprises data for configuring an imaging device from the facial portion and/or from the edge portions (Brinkman, Abstract and col. 21, lines 10-20).

Regarding claim 2, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is positioned on the facial portion and on an adjacent and substantially perpendicular edge portion; and wherein the fluid-based marking comprises data for configuring operations of the imaging device (Brinkman, Fig. 14A-14C, 16A-16C and associated text).

Regarding claim 3, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is imprinted on the edge portions and not imprinted on the facial portions, the fluid-based marking having bled onto the facial portions (Brinkman, Fig. 14A-14C, 16A-16C and associated text).

Regarding claim 4, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is ink (Brinkman, Abstract and col. 21, lines 10-20).

Regarding claim 31, Brinkman teaches a sheet as recited in claim 1, wherein the data is for configuring the image device to form images on the sheet (Brinkman, Fig. 14A-14C, 16A-16C and associated text).

Claims 1-4 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,598,783 to Brinkman.

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Brinkman teaches a sheet of print media (Brinkman, Fig. 1A-1B, 5B-5C, 6C, 7B, 7F-7I, and 11-12 and associated text), the sheet comprising: facial portions; edge portions; a single fluid-based marking positioned on a facial portion and on an edge portions, the edge portions covering an area that is adjacently positioned and substantially perpendicular to an area of the facial portion; and wherein the single fluid-based marking comprises data for configuring an imaging device from the facial portion and/or from the edge portions (Brinkman, Abstract and col. 2, lines 22-35).

Regarding claim 2, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is positioned on the facial portion and on an adjacent and substantially perpendicular edge portion; and wherein the fluid-based marking comprises data for configuring operations of the imaging device (Brinkman, Fig. 1A-1B, 5B-5C, 6C, 7B, 7F-7I, and 11-12 and associated text).

Regarding claim 3, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is imprinted on the edge portions and not imprinted on the facial portions, the fluid-based marking having bled onto the facial portions (Brinkman, Fig. 1A-1B, 5B-5C, 6C, 7B, 7F-7I, and 11-12 and associated text).

Regarding claim 4, Brinkman teaches a sheet as recited in claim 1, wherein the single fluid-based marking is ink (Brinkman, Abstract and col. 2, lines 22-35).

Regarding claim 31, Brinkman teaches a sheet as recited in claim 1, wherein the data is for configuring the image device to form images on the sheet (Brinkman, Fig. 1A-1B, 5B-5C, 6C, 7B, 7F-7I, and 11-12 and associated text).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 32, and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,598,783 to Brinkman.

Brinkman essentially teaches the claimed invention relied upon above.

Brinkman does not teach claims 5, 32, and 38 to a plurality of facial or edge portions or to a stack of print media comprising a plurality of sheets, each sheet being a sheet as recited in claim 1.

Unless the reference teaches away from duplicating said sheet, it is obvious to provide a plurality of facial portions, edge portions and sheets as claim 1 or 32 motivated by the desire of providing multiple markings for identification at more than one location. Additionally, the mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

To claim 34, because the prior art does not expressly disclose a sheet having sufficient capillary action properties to carry the fluid-based marking, the Examiner interprets that the sheet of the prior art does not have sufficient capillary action.

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To claims 35-36, that the fluid-based marking *was* generated in part as a function and positioning of a mask, where the mask having been placed over the sheet and having been offset at an angle of skew are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Both Applicant's and prior art reference's product are the same. Further, the mask is not part of the sheet media, because the mask is not adding any positive recitation to the claims.

To claims 37 and 39-40, how markings were generated by various process and that each of the sheets are being skewed at an angle are process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 5, and 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,090,027 to Brinkman.

Brinkman essentially teaches the claimed invention relied upon above.

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Brinkman does not teach claims 5, 32, and 38 to a plurality of facial or edge portions or to a stack of print media comprising a plurality of sheets, each sheet being a sheet as recited in claim 1.

Unless the reference teaches away from duplicating said sheet, it is obvious to provide a plurality of facial portions, edge portions and sheets as claim 1 or 32 motivated by the desire of providing multiple markings for identification at more than one location. Additionally, the mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

To Claim 33, Brinkman teaches the fluid-based marking is a barcode (col. 21, lines 16-35).

To claim 34, because the prior art does not expressly disclose a sheet having sufficient capillary action properties to carry the fluid-based marking, the Examiner interprets that the sheet of the prior art does not have sufficient capillary action.

To claims 35-36, that the fluid-based marking *was* generated in part as a function and positioning of a mask, where the mask having been placed over the sheet and having been offset at an angle of skew are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

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Both Applicant's and prior art reference's product are the same. Further, the mask is not part of the sheet media, because the mask is not adding any positive recitation to the claims.

To claims 37 and 39-40, how markings were generated by various process and that each of the sheets are being skewed at an angle are process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

NOTATION

The subject matter of a properly construed claim is defined by the terms that limit its scope. It does not appear claims 35-37 and 39 positively claim the mask or markings because the claims are written in past tense. Should applicant positively recite the claims, (e.g. claiming what is, instead of what was) allowable subject matter will be indicated.

Response to Arguments

9. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

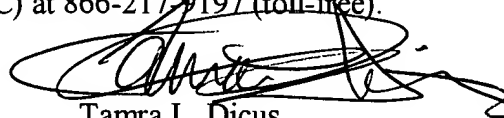
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

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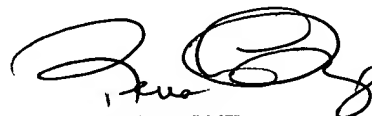
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

May 18, 2005



RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774

5/20/05